

REMARKS

Claims 6-17 have been added. Hence, Claims 1-17 are present in this case.

REQUEST FOR RECONSIDERATION

Restriction has been required from among the following three aspects of the present invention:

- 1) Claim 1, drawn to an aqueous emulsion composition (Group I);
- 2) Claims 2 and 3, drawn to a method of backing a carpet (Group II); and
- 3) Claims 4 and 5, drawn to a carpet which is backed (Group III).

Identified aspects 1) and 3) above are said to be related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if:

...the intermediate product is useful to make other than the final product (MPEP § 806.04(b), third paragraph), and the species are patentably distinct (MPEP § 806.04(h)).

In the present case, the Examiner is of the opinion that the intermediate product is useful as a binder for nonwoven fibrous webs and there is nothing on the record to show these aspects to be obvious variants.

However, the Examiner has not explained why the proposed use as a "binder for non-woven fibrous web" constitutes "other than the final product", since page 2 of the present specification describes that the such non-woven fabrics may, themselves, be part of the carpet backing.

Furthermore, the record does not support the conclusion that the species are patentably distinct as there is nothing of record which suggests the same. This is the Examiner's burden, in the first instance.

Identified aspects 1) and 2) above are said to be related as product and process of use. As such, inventions in these categories can be shown to be distinct if either or both of the following can be shown:

...(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process if using that product (MPEP § 806.05(h)).

In the present case, the Examiner is of the opinion that the aqueous composition can be used in a materially different process of using the product such as using the aqueous emulsion composition "to bind nonwoven fibrous web".

However, as noted above, there is nothing of record which supports the conclusion that the proposed process of use is a "materially different process" from that presently claimed. See page 2 of the present specification.

Finally, identified aspects 2) and 3) above are said to be related as process of making and product made. As such, inventions in these categories are distinct if either or both of the following can be shown:

...(1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

In the present case, the Examiner is of the opinion that the product as claimed can be made by another and materially different process such as "simultaneously thermally curing and drying the emulsion coated on the underside surface of the carpet". See page 3 of the Restriction Requirement.

However, the Examiner has not explained why the proposed process of making constitutes a "materially different process" from that presently claimed.

Hence, for all of the above reasons, the requirement for restriction is believed to be

improper and should be withdrawn.

Furthermore, Applicants are mindful of the test MPEP § 803, which provides:

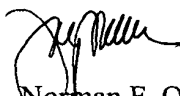
If the search and examination of an entire application can be made without serious burden, the Examiner is required to examine all claims on the merits even if directed to independent or distinct inventions.

In the present case, it is not seen, nor has any reason been provided to explain, why a search of only three subclasses would constitute the "serious burden" mandated by MPEP § 803 in order to justify restriction. In the absence of, at least, such an explanation, it can only be concluded - by default - that the burden is not serious. Hence, a search and examination of all aspects of the present invention should now proceed without delay.

Favorable consideration is earnestly solicited.

Respectfully submitted,

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IN THE CLAIMS

--Claims 6-17 (New).--

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